

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Heiman
Appeal No. 2009-009257

Serial No.: 10/696,683
Filed: October 29, 2003
Group Art Unit: 1794
Examiner: Jennifer A. Chriss
Appellant: Gary L. Heiman
Title: ENHANCED SURFACE GEOMETRY SHEETING
Attorney Docket: STAN-31
Conf. No.: 5261

Cincinnati, OH 45202

May 17, 2010

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

I hereby certify that this correspondence for Application No. 10/696,683 is being electronically transmitted to the Board of Patent Appeals and Interferences, via EFS-WEB, on May 17, 2010.

/Randall S. Jackson, Jr./
Randall S. Jackson, Jr.,
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REMARKS

Appellant respectfully requests a rehearing of the March 17, 2010 Decision ("the Decision") by the Board affirming the Examiner's Rejections (1), (2), and (5)¹ of claims 1, 3, 14, 16, 33, and 36 through 40.² To that end, Appellant submits that the Board has misapprehended or overlooked the following points as set out below.

The remarks herein focus on independent claim 1, but it should be readily apparent the same applies to independent claim 33 insofar as claim 33 can be viewed as a claim depending from claim 1, wherein $x = 2$ and $y = 1$.

Also, as a part of this reply, Appellant has included the declaration of Richard Stewart ("The Stewart Declaration") pursuant to 37 C.F.R. §1.132. The Stewart Declaration is attached as Exhibit A.

Rejection (1): The Board's affirmation of the §102 rejection over Love is wrong as a matter of law

Claim 1 specifically requires a woven fabric that comprises, in part, at least one warp yarn being a spun yarn of natural fibers. [underlining for emphasis]. In other words, at least one warp yarn is made solely of natural fibers. The decision of the Board ignores that very limitation, despite clear law that forbids treating that limitation as an open term merely because the preamble of the claim allows for additional elements. But that is not an invitation to add elements into that specific limitation.

Even though claim 1 expressly requires that there be a spun yarn that is made only of natural fibers, the Board states that "Appellant's open-ended transitional claim language

¹ The Examiner's cumulative rejections (3) and (4) were vacated by the Board.

² Claims 5-8 and 13 stand withdrawn.

'comprising' in claims 1 and 33 does not exclude additional fibers, such as Love's synthetic fiber, as a component in its spun yarn." *See* page 5 of the Decision. The Board further goes on to state, quite curiously, that "it is immaterial whether Love teaches a synthetic fiber as a component in its spun yarn because Appellant has not limited the claims to require that the spun yarn be formed from only natural fibers." *Id.* Quite to the contrary, claim 1 expressly states that the fiber of at least one of the yarns must all be natural, which is directly at odds, and wholly undercuts, the conclusions stated by the Board.

At bottom, the Board tries to restate the claim limitation merely because the preamble of the claim includes the open ended term "comprising". That is not in accord with the law as an open ended preamble cannot be used to abrogate claim limitations. *See, e.g., Dippin Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed. Cir. 2007) (the transitional "phrase 'comprising' is not a weasel word with which to abrogate claim limitations"). At most, the claim can be read as having yarns that are or include synthetic fibers, but must still have at least one yarn that does not, i.e., at least one of the warp yarns must be a spun yarn, the fiber of which are all natural. *Id.* (recognizing that the presumption arising from "comprising" in the preamble cannot be used to reach into limitations of the claim to render every word and phrase therein open-ended). *See also Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379-80 (holding that the term "comprising" cannot restore subject matter otherwise excluded from the claim). Here, the Board has committed a fatal error by ignoring that Love does not teach the required yarn.

The warp yarns disclosed in Love must include a synthetic fiber because it is clearly directed to woven stretch fabrics that have at least about 50% or greater of a synthetic fiber component, in order that the yarn will retain its structural conformation after a heat setting process. The fabrics can be made from yarns containing synthetic fibers, blends of two or more

types of synthetic fibers, or blends of synthetic fibers and natural fibers; and the yarns can be made of spun or filament yarns. *See* abstract, paragraph [0014], and the Examples. Thus, there is no teaching in Love of a woven fabric having a spun yarn (let alone a spun warp yarn) made solely of natural fibers. At best, Love discloses a spun yarn that is a blend of natural and synthetic fibers, which is not a yarn solely of natural fibers. Hence, the Board erred in concluding that Love anticipates the claimed invention. *See, e.g., Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.).

Rehearing of the Board's Decision and reversal of Examiner's Rejection (1), and consequently Rejection (2) rejecting dependent claims 36 and 37 over Love, is respectfully solicited.

Rejection (5): The Board's basis for the affirmation of the Obviousness-Type Double Patenting Rejection based on Heiman and the Fairchild Dictionary is factually flawed

Claim 1 requires warp yarn floats repeating along substantially the length of respective warp yarns in a defined float pattern (*e.g.*, 2x1, 3x1, or 4x1 float patterns, not a plain weave pattern).

The Board's affirmance of the rejection of claim 1 for nonstatutory obviousness-type double patenting over claims 1-21 of Heiman in view of the Fairchild Dictionary is premised on factually insufficient information.³ In particular, the Decision assumes that one would substitute the 1x1 plain weave of Heiman with the twill weave, *e.g.*, 2x1 pattern, of the Fairchild dictionary

³ In the event the Board is otherwise inclined to continue to affirm Rejection (5) (which Appellant submits is in error and should be reversed), Appellant respectfully requests that the Board exercise its power as set forth in 37 C.F.R. §41.50(c) in order to streamline further prosecution.

"since twill weaves are a commonly known weave structure which is known to produce a strong, durable fabric." Page 11 of the Decision. However, the converse is understood in the art. Specifically, a twill weave, e.g., a 2x1, is not as strong as a conventional 1x1 plain weave pattern, as is disclosed in Heiman, as a result of the float patterns introduced into the fabric. In support thereof, Appellant refers the Board to the Stewart Declaration, wherein the Declarant Richard Stewart, an expert in the textile industry, states.

A woven fabric sheeting having a twill weave, e.g., a 2x1 pattern, is not as strong a fabric when compared to a woven fabric having a conventional 1x1 plain weave pattern, as is disclosed in Heiman U.S. Patent No. 5,495,874 ("Heiman"). The additional float patterns introduced into the fabric, via the twill weave, lessen the strength of the woven fabric. And if faced with maintaining the strength of the woven fabric, I would not look to replace a 1x1 plain weave with a weaker 2x1 twill weave. *See* Stewart Declaration, Paragraph 9.

In view thereof, it is submitted that one having ordinary skill in the art would not replace the stronger 1x1 plain weave of Heiman for the weaker 2x1 twill weave disclosed in the Fairchild dictionary, as assumed by the Board. In addition thereto, as compared to a 1x1 plain weave pattern, it is also well known that a twill weave, e.g., a 2x1 pattern, is more expensive to produce and consequently sell, because of the additional patterning involved with a twill weave operation. Again, in support thereof, Appellant refers the Board to the Stewart Declaration, wherein the expert Richard Stewart states.

A woven fabric sheeting having a twill weave, e.g., a 2x1 pattern, is more expensive to produce and, consequently, sell, as compared to a woven fabric having a 1x1 plain weave, because of the additional patterning involved with providing the twill weave. *See* Stewart Declaration, Paragraph 10.

And this directly contradicts the sole objective of Heiman, which is as follows:

The object of the present invention is to provide an improved, fabric sheeting which has a blend of the durability characteristics of a polyester fabric and the "feel", absorbency and other desirable characteristics of a cotton fabric, and particularly to do so in a fashion that reduces the acquisition cost of sheeting and bed linens and other products made therefrom. Emphasis added. *See* col. 3, lines 10-16.

Based on all of the above, Appellant submits that the conclusion reached by the Board as to motivation to combine Heiman with the Fairchild dictionary is unsupportable. Rehearing of the Board's Decision and reversal of Examiner's Rejection (5) is thus also respectfully solicited.

Respectfully submitted,
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